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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/728,340   | 12/01/2000  | Tom Vicknair         | P/2167-253          | 5053             |
| 32172  | 7590        | 02/04/2005           | EXAMINER            |                  |
| DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP<br>1177 AVENUE OF THE AMERICAS (6TH AVENUE)<br>41 ST FL.<br>NEW YORK, NY 10036-2714 |             |                      | DASS, HARISH T      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3628                |                  |

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/728,340             | VICKNAIR ET AL.     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Harish T Dass          | 3628                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 November 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10 and 35-45 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10 and 35-45 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

Claims 11-35 and 46-66 are cancelled.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 and 36-45 are rejected Geer (US 5,930,778) in view of Josephson et al (hereinafter Josephson - US 5,532,464) and Cahill et al (hereinafter Cahill - US 5,678,046).

Re. Claims 1, Geer discloses a system for expedited processing of checks and cash items received by a payee, electronic files that mirror paper cash letters and detail records [see entire document particularly - Abstract; Figures 1-2; C1 L1 to C6 L20], receiving an electronic cash presentment (ECP or transmission of the transactional check data) file, the ECP file containing first records representing paper-based banking transactions [C2 L4-L15; C4 L26 to C5 L9; C7 L25-61; C9 L1-L10; C18 L1-L18],

for each of the first records, assigning a unique first item sequence number to each respective first record [C7 L38-L58],

receiving the paper-based banking transactions [C4 L45 to C5 L10],

generating second records representing the paper-based banking transactions [C15 L17-L19],

for each of the second records, assigning a unique second item sequence number to each respective second record [C13 L44-L49], and

correlating the first and second records (second record translatable to financial instrument or checks) [C13 L44-L49].

Geer does not explicitly disclose receiving the paper-based banking transactions after having received the ECP file, and discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number.

However, Josephson discloses ECP and receiving the paper-based banking transactions after having received the ECP file [see entire document particularly, Abstract; Figures; C1 L36-L58; C3 L32 to C5 L9; C8 L35-L51; C27 L37 to C28 L3] to prepared a detail list of all unmatched records prepared by matching the electronic and actual paper transaction information to protect against loss for unpaid or return checks. Additionally, Cahill discloses a method and apparatus for storing and retrieving images of documents, e.g. checks [see entire document particularly, Abstract; Figures 1-5, 27-30; C1 L1 to C10 L62] and discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number [C15 L43-L67] to improve application performance and process query quickly to access a record. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Geer, Josephson and Cahill to

receiving the paper-based banking transactions after having received the ECP file, and discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number in order to improve the performance of the for preparing a report of unmatched records by matching the electronic file content and actual paper transaction for avoiding loss for unpaid checks or return checks.

Re. Claim 2, Geer discloses further comprising performing financial processing with respect to each of the first records [Geer –C3 L30-L55; C4 L26-L42].

Re. Claim 3, Geer discloses wherein the financial processing comprises posting the banking transaction [Geer –C3 L30-L55; C4 L26-L42].

Re. Claim 4, Geer discloses wherein the step of correlating the first and second records further comprises performing a proofing process (verification) [C14 L17-L40].

Re. Claim 5, Neither Geer nor Josephson discloses further comprising, prior to the proofing process, sorting the ECP file according to a key to generate an index file, wherein the order of the seconds is thereby irrelevant in the proofing process. However, Cahill further discloses this feature [C9 L32-L36; C29 L1-L40] to use as a primary key. It would have been obvious at the time the invention was made to a person having

ordinary skill in the art to combine the disclosures of Geer, Josephson and Cahill to revive image record using index as an alternate search key.

Re. Claim 6, Geer discloses wherein the key is selected from the group consisting an account number, a transit number, amount, check number, posting date, the first item sequence number and a payor bank number, each being associated with the paper-based banking transaction [Geer – C7 L38-L62].

Re. Claim 7, Geer discloses wherein the step of generating the second records further comprises generating digital images of the paper-based banking transactions [Geer - C15 L17-L19].

Re. Claim 8, Geer discloses further comprising storing the digital images in an archive [C8 L10-L67; C15 L17-L19; C17 L5-L8].

Re. Claim 9, Geer discloses further comprising generating first digital images of paper-based banking transactions that were not represented in the ECP file (electronic files that mirror paper cash letters and detail records) [C4 L26-L42; C8 L9-L67].

Re. Claim 10, Geer discloses generating second digital images of the paper-based banking transactions that were represented in the ECP file, and storing the first and the second digital images in an archive [C8 L9-L67; C15 L7-L19; C17 L5-L8].

Re. Claim 36, claim 36 is rejected with same rational as claim 1.

Re. Claim 37, claim 37 is rejected with same rational as claim 2.

Re. Claim 38, claim 38 is rejected with same rational as claim 3.

Re. Claim 39, claim 39 is rejected with same rational as claim 4.

Re. Claim 40, claim 40 is rejected with same rational as claim 5.

Re. Claim 41, claim 41 is rejected with same rational as claim 6.

Re. Claim 42, claim 42 is rejected with same rational as claim 7.

Re. Claim 43, claim 43 is rejected with same rational as claim 8.

Re. Claim 44, claim 44 is rejected with same rational as claim 9.

Re. Claim 45, claim 45 is rejected with same rational as claim 10.

### ***Response to Arguments***

2. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicant's argument there is no description of the receipt of an ECP, see [Geer C4 L19-L67; C9 L1-L10; C18 L1-L18] which shows that the prior art is describing ECP, as Examiner reads it.

In response to Applicant's argument that third processor is not recited. Any system capable of executing multi-threaded or multiprocessor modules, database and matching module (query to compare two record) can perform this task.

***Conclusion***

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Sough can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass  
Examiner  
Art Unit 3628

1/31/05



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